REMARKS

The Applicants appreciate the Examiner's careful consideration of their application and respectfully request reconsideration followed by allowance.

Rule 133 Statement

Before addressing the present Amendment in detail, Applicants' representative wishes to acknowledge the Examiner's courtesy and constructive dialog during a telephone interview conducted on or about January 9, 2004. Rejoinder of SEQ ID NO:7 was discussed and it is understood that the Examiner remains of the view that claims to such nucleotide sequence belong in a divisional application. Proposed amendments to claim 1 were discussed taking into account the Examiner's view as to SEQ ID NO:7. The proposed amendments were deletion of SEQ ID NO:7 from claim 1 without prejudice to filing a divisional application. It was also suggested that as to SEQ ID NO:24, the segue to its recital might lingusitically read better if 'comprising' were changed to 'containing', it being posited on behalf of Applicants that the linguistic change ought not to contract claim scope. It was understood that such amendments would be enterable. The addition of claims, such as dependent claims 13 and 14, was discussed with the Examiner as well. The common inventive entity between the present application and the cited U.S. Patent No. 5,959,176 was discussed as well as the common assignee. The Examiner was advised that Applicant Nishikawa used her married name in this application and she is the inventor having the last name Torikai who listed on the cited U.S. Patent, and that a declaration/affidavit to such effect could be supplied.

Again, Applicants' representative expresses appreciation for the Examiner's courtesy and helpful comments during the telephone interview.

Amended claims:

Amended claim 1 deletes reference to SEQ ID NO:7 without prejudice to filing any further application, such as a divisional application, for the non-elected SEQ ID. See, Paper No. 10, dated July 16, 2002. Amended claim 1 also includes a linguistic change of

"comprising" to "containing" for readability but without any intention of contracting claim scope.

New claims 13 and 14 are proposed and they are respectively directed to the promoter comprising DNA (a) and the promoter comprising DNA (b) in proposed amended claim 1.

Attachments:

A signed copy of the appended Declaration (or its equivalent) will be submitted. The Declaration is intended to respond to the prior art rejection in the August 26, 2003 Office Action by showing common inventive entities between this application and the cited U.S. Patent.

Traversing the Rejection Under 35 U.S.C. §112(¶1).

Applicants respectfully submit their specification satisfies the statutory requirements of 35 U.S.C. §112(¶1). Please reconsider and withdraw the rejections of claims 1 and 3-10 "as failing to comply with the written description requirement."

The pertinent statutory provision in the patent law, Section 112(1) provides, in relevant part, that:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112 (¶1) (2000). Three separate requirements are contained in that provision: (1) "[t]he specification shall contain a written description of the invention"; (2) "[t]he specification shall contain a written description . . . of the manner and process of making and using it [i.e., the invention] in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly

connected, to make and use the same"; and (3) "[t]he specification . . . shall set forth the best mode contemplated by the inventor of carrying out his invention."

These three requirements are referred to as the "written description requirement," the "enablement requirement," and the "best mode requirement," respectively. *See,* In re Moore, 439 F.2d 1232, 1235 (CCPA 1971) ("This first paragraph analysis in itself contains several inquiries. Considering the language of the statute, it should be evident that these inquiries include determining whether the subject matter defined in the claims is described in the specification, whether the specification disclosure as a whole is such as to enable one skilled in the art to make and use the claimed invention, and whether the best mode contemplated by the inventor of carrying out that invention is set forth.").

Applying the statutory criteria, Applicants' specification contains a written description of the invention in such a way as to reasonably convey to a person skilled in the art that the Applicants' had possession of their claimed inventions when their application was filed. It is, of course, understood that their specification does not need to recite *in hoc verba* claim language to comply with 35 U.S.C. §112(¶1) and the "written description requirement."

The present specification describes the inventions to a person who is skilled in the art. Structural attributes common to members within the DNA of (b) in claim 1 are described. For instance, the specification contains a written description of the DNA comprising the nucleotide sequence shown in SEQ ID NO:1, as well as DNA comprising the nucleotide sequences shown in SEQ ID NO: 3, SEQ ID NO:4, SEQ ID NO:5, and, for example, SEQ ID NO:7, all of which are within the scope of the previously submitted claim 1 (b).

More specifically as to SEQ ID NO:3, 4, 5 and 7, the Examiner is respectfully invited to consider additionally the differences between those sequences and the DNA (a) in claim 1(a).

a. SEQ ID No:3 differs from SEQ ID NO:1 by a 2 nucleotide substitution and a 4 nucleotide deletion. SEQ ID NO:3 contains a nucleotide substitution at nucleotide Nos. 2034 and 2045 (corresponding to nucleotide Nos. 2038 and 2049 of SEQ ID NO:1). In SEQ ID NO:3, 4 nucleotides corresponding to nucleotide Nos. 878 to 881 of SEQ ID NO:1 are deleted. SEQ ID NO:3 contains the nucleotide sequence of SEQ ID NO:24 (i.e., the sequence of nucleotide Nos. 1746 to 1775 in SEQ ID NO:1) at nucleotide Nos. 1742 to 1771.

b. SEQ ID NO: 4 differs from SEQ ID NO:1 by a 2 nucleotide substitution and a 4 nucleotide deletion. SEQ ID No:4 contains a nucleotide substitution at nucleotide Nos. 2034 and 2045 (corresponding to nucleotide Nos. 2038 and 2049 of SEQ ID NO:1). In SEQ ID NO:4, 4 nucleotides corresponding to nucleotide Nos. 418 to 421 of SEQ NO:1 are deleted. SEQ ID NO:4 contains the nucleotide sequence of SEQ ID NO:24 (i.e., the sequence of nucleotide Nos. 1746 to 1775 in SEQ ID NO:1) at nucleotide Nos. 1742 to 1771.

c. SEQ ID NO:5 differs from SEQ ID NO:1 by a 2 nucleotide substitution and a 4 nucleotide insertion. SEQ ID NO:5 contains a nucleotide substitution at nucleotides Nos. 2042 and 2053 (corresponding to nucleotide Nos. 2038 and 2049 of SEQ ID NO:1), and 4 nucleotides insertion at nucleotide Nos. 1810 to 1814 (corresponding to between nucleotide Nos. 1809 and 1810 of SEQ ID No.1). SEQ ID NO:5 contains the nucleotide sequence of SEQ ID NO:24 (i.e., the sequence of nucleotide Nos. 1746 to 1775 in SEQ ID NO:1) at nucleotide Nos. 1746 to 1775.

d. SEQ ID NO:7 differs from SEQ ID NO:1 by 2 nucleotides substitution. SEQ ID NO:7 contains a nucleotide substitution at nucleotide Nos. 2038 and 2049 (corresponding to nucleotide Nos. 2038 and 1049 of SEQ ID

NO:1). SEQ ID NO:7 contains the nucleotide sequence of SEQ ID NO:24 (i.e., the sequence of nucleotide Nos. 1746 to 1775 in SEQ ID NO:1) at nucleotide Nos. 1746 to 1775.

Furthermore, the nucleotide sequence of SEQ ID NO:24, recited in (b) of the proposed Claim 1, is the nucleotide sequence of oligonucleotide S described in Example 6 (2), and corresponds to the nucleotide sequence indicated by nucleotide Nos. 1746 to 1775 in SEQ ID No:7. The sequence of nucleotide Nos. 1746 to 1775 in SEQ ID No:7 is the same as the sequence of nucleotide Nos. 1746 to 1775 in SEQ ID NO:1. The alignments of the nucleotide sequence of SEQ ID NO:24 against the nucleotide sequence of SEQ ID NO:1 or SEQ ID NO:7 are shown below:

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1741 :  GTTTGAACAA TGTATGTCCG GTGTACATCT ATGACCTTTC    SEQ ID No:1
        ***** ********** ********** *****
   1 :  -----AACAA TGTATGTCCG GTGTACATCT ATGAC-----    SEQ ID No:24

1741 :  GTTTGAACAA TGTATGTCCG GTGTACATCT ATGACCTTTC    SEQ ID No:7
        ***** ********** ********** *****
   1 :  -----AACAA TGTATGTCCG GTGTACATCT ATGAC-----    SEQ ID No:24
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Thus, the nucleotide sequence of SEQ ID NO:24 (oligonucleotide S) is contained in both SEQ ID NO:1 and SEQ ID NO:7, (although the oligonucleotide S is described as a primer in PCR using a SEQ ID NO:7 at page 44).

Accordingly, SEQ ID NO:3, SEQ ID NO:4, SEQ ID NO:5 and SEQ ID NO:7 satisfy structural attributes that are common to the members of the claim 1(b) DNA, that is: DNA comprising the nucleotide sequence in which one or more bases are deleted, substituted, or added in the nucleotide sequence shown in SEQ ID NO:1, and which has more than 90% identity to the nucleotide sequence of any region consisting of 250 bp or more within the nucleotide sequence shown in SEQ ID NO:1, and which contains the nucleotide sequence shown in SEQ ID NO:24.

Finally, as noted in the prior response, since this specification is directed to a person who is skilled in the art, Applicants point out that a so-called TATA box is an element in a DNA to provide the promoter function in a plant cell. For instance, those skilled in the art would read the specification and understand that the so-called TATA box provides a DNA binding site for Transcription Factor II D in a plant cell. Given this understanding, a person who is skilled in the art would appreciate from the present specification that DNA's described as having such promoter function would at least have in common a TATA box encoded therein.

Therefore it is respectfully submitted that the originally filed specification sets forth sufficient detail to allow a person who is skilled in the art to understand what is claimed and to recogize that Applicants were in possession of and invented their claimed inventions herein at the time their application was filed.

Traversing the Prior Art Rejection Over U.S. Patent No. 5,959,176:

Applicants respectfully traverse the prior art rejection at pages 9 *et seq.* Claims 1 and 3-10 were rejected under 35 U.S.C. §102(e) over the Torikai et al. reference (U.S. Patent No. 5,959,176), commonly assigned to Sumitomo Chemical Co., Ltd.

The present application is entitled to an effective priority date of October 2, 1998, has an assignee that is the same as the Torikai et al. reference, and in fact has common inventorship with the Torikai et al. reference. The reference would therefore appear to be disqualified as being prior art under 35 U.S.C. §102(e) by virtue of amended 35 U.S.C. §103(c).

In addition, and independently, Examiner will appreciate the inventor named Satomi Torikai, now following marriage, is known as Satomi Nishikawa. The person is obviously one and the same. Applicants enclose a Declaration to such effect.

In any event, it will be appreciated that even if, *arguendo*, the Torikai et al. reference were prior art, it does not describe the subject matter of claim 1, including the attributes as noted previously herein. Accordingly, the promoter of claim 1 would not be anticipated by the Torikai et al. reference (or even its EP counterpart, EP0824150 published on February 18, 1998). Even if the promoter sequence (SEQ ID NO:2) in the cited Torikai et al. reference, were, *arguendo,* prior art, the Examiner can see that it does not contain, for instance, a SEQ ID NO:24 or the like, as compared to claim 1(b) (see, for the sake of argument, nucleotides 1737-1766 in the Torikai et al. SEQ ID NO:2 versus Applicants' SEQ ID NO:24). Thus, the reference neither describes nor would it have suggested claim 1(b) to a person of ordinary skill in the art, notwithstanding the Torikai et al. SEQ ID NO:2, whereby Applicants respectfully submit their claimed inventions are patentable over the Torikai et al. even if, *arguendo*, it was prior art.

Applicants have endeavored to respond to all matters raised in the Office Action. If Applicants' response to the Office Action is found wanting is any respect, please contact the undersigned.

Applicants respectfully submit their application is in condition to receive a notice of allowance.

Respectfully submitted,

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